

Appln. No. 09/975,460
Amdmt Dated August 12, 2004
Reply to Office Action mailed on May 14, 2004

REMARKS

Claims 20-59 and 61-72 are pending in the application. Applicant thanks Examiner Dixon for acknowledging the allowable subject matter of claims 20-27, 36-48, 56-59 and 61-72. Reconsideration of the pending rejection and allowance of claims 28-35 and 49-55 in light of the amendments and remarks herein are respectfully requested.

Rejection under 35 U.S.C. § 102

Claims 28-35 and 49-55 stand rejected pursuant to 35 U.S.C. § 102 as being unpatentable over Bouve *et al.* U.S. Patent No. 5,682,525 ("Bouve") or Ogasawara U.S. Patent No. 6,123,259 ("Ogasawara"). Claims 28-30, 32-35, 49-51, and 53-55 have been amended. Support for these amendments may be found at least at original claims 10-17. By these amendments, the scope of the claims has not been narrowed, and the claims are entitled to the full range of equivalents. Applicant respectfully submits that the cited references do not disclose the limitations of claims 28-35 and 49-55 for the following reasons.

Claims 28-30, 32-35, 49-51, and 53-55 have been amended to recite "code segments" as elements of a computer program in the apparatus. In the Office Action, the functional language was given no weight. With this amendment, the functional language of each code segment must be given weight because computer programs embodied in a tangible medium are patentable subject matter and must be examined under 35 U.S.C. §§ 102 and 103. *In re Beauregard*, 35 U.S.P.Q.2d 1383 (Fed. Cir. 1995); *In re Lowry*, 32 U.S.P.Q.2d 1031 (Fed Cir. 1994).

First, with respect to *Bouve*, Applicant respectfully submits that *Bouve* does not disclose the limitations of independent claims 28 and 49. Claims 28 and 49 each relate to an apparatus

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that delivers a customized offer for an item of merchandise. The apparatus of amended claims 28 and 49 recite, *inter alia*, "code segment[s]" that obtain information identifying an item that a user desires, query a computer network based on the information and the location of the user; receive a customized offer for sale of an item of merchandise from a retailer-based agent in response to the query; and display the customized offer and a physical location of the retailer. Claim 49 recites additional "code segment[s]" that determine the closest retailers surrounding the user, and suggest items of merchandise for sale at the closest retailers surrounding the user.

In comparison, *Bouve* describes "remotely determining the position of a selected category of items of interest in a selected geographic vicinity from a database." (col. 2, ll. 10-13). *Bouve* defines 'items of interest' as "services, products, geographic sites, architectural sites stores, restaurants, public services, or other items which a user of the invention may wish to locate" (col. 1, ll. 61-64). The information stored in the database about the items of interest does not include items for sale at a retailer. The information merely includes information that is readily available about an item of interest, "including information about locating an item of interest."

Bouve does not describe information that is available solely from a retailer, such as an offer for sale of an item of merchandise. *Bouve* does not disclose a customized offer for sale of an item of merchandise in response to a query. In particular, *Bouve* does not describe "logic element[s]" that obtain information identifying an item that a user desires, query a computer network based on the information and the location of the user; receive a customized offer for sale of an item of merchandise from a retailer-based agent in response to the query; or display the customized offer and a physical location of the retailer, as recited by claims 28 and 49. In addition, *Bouve* does not describe a "code segment" that determines the closest retailers

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surrounding the user, or suggests items of merchandise for sale at the closest retailers surrounding the user, as additionally recited by claim 49. Because *Bouve* does not describe each limitation of claims 28 and 49, Applicant respectfully submits that claims 28 and 49 are not anticipated by *Bouve*. Accordingly, Applicant respectfully requests reconsideration of the rejection of independent claims 28 and 49.

Second, with respect to *Ogasawara*, Applicant respectfully reminds the Examiner that the *Ogasawara* reference was properly removed as prior art. As discussed in Applicant's Response dated August 15, 2003, the invention of the pending claims, at least insofar as the portions of the invention are disclosed by *Ogasawara*, was completed before the filing date of *Ogasawara*. Applicant's Declaration Under Rule 131 attached to the Response of August 15, 2003 set forth facts establishing completion of at least the relevant portions of the invention in the United States before the filing date of *Ogasawara* and included references in support thereof. Indeed, the Office Action of October 10, 2003 acknowledged that the Declaration and the Response were deemed convincing, and therefore, *Ogasawara* was removed as prior art against the pending claims. The present Office Action provides no explanation as to why the previous decision was overturned and the claims rejected based on *Ogasawara*.

Notwithstanding the removal of *Ogasawara* as prior art, Applicant respectfully submits that *Ogasawara* does not disclose the limitations for the "code segments" of independent claims 28 and 49, as described above. Accordingly, Applicant respectfully requests that the rejection of claims 28-35 and 49-55 under 35 U.S.C. § 102 based on *Ogasawara* be withdrawn.

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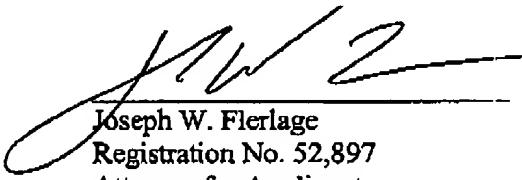
Claims 29-35 and 50-55 depend from claims 28 and 49, respectively. Therefore, Accordingly, claims 29-35 and 50-55 recite limitations not found in the above-noted prior art. Accordingly, claims 29-35 and 50-55 are also in a condition for allowance.

CONCLUSION

According to the amendments and reasons presented above, the application is in a condition for allowance. Withdrawal of the pending rejection is respectfully requested and allowance of all pending claims is earnestly solicited. The Examiner is invited to call the undersigned attorney at the telephone number listed below if a telephone conference would expedite allowance of the application.

Respectfully submitted,

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